

REMARKS

This amendment is made in response to the Office Action dated March 23, 2004.

Applicants have attempted to address every issue raised by the Examiner and believe that the claims are now in condition for allowance. Withdrawal of the rejections and allowance of these claims is respectfully requested. Claims 1 and 3 have been further amended to better distinguish the claimed product from that of the prior art.

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Daems et al. in U.S. Patent No. 6,156,416. The Examiner argues that the process limitations are not dispositive of the issue of the patentability of the article claims. Applicants respectfully traverse this rejection.

The present invention requires the presence of a size coat between the article and the image-receiving layer. Daems discloses only a transfer foil having a release layer between the transfer sheet and the image-receiving layer. When the transfer sheet is applied to the article, the image-receiving layer would be positioned adjacent the article with the release layer away from the article. This is confirmed in the examples where the image was placed in contact with the surface of a sheet of ABS polymer. After application, the image-receiving layer would be sandwiched between the article and the release layer. In the finished article of Daems, the image-receiving layer would be in the middle, not on top of the three layers as required by Applicants' claims. Thus, Daems does not anticipate Applicants' claims and Applicants request that this rejection be withdrawn.

Claims 3-11, 20 and 21 further stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Daems. Applicants' suggest that the Examiner has failed to establish a *prima facie* case of obviousness, that respectfully traverses this rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Second, there must be a reasonable expectation of success. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Finally, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is

nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

The Examiner has not suggested a specific modification to Daems that would result in Applicants' claimed product. Nowhere does Daems teach or suggest the benefits of applying the image-receiving between the image and the article. The outstanding Office Action states a conclusion that Applicants' claims are obvious, but does not state how to modify either reference. Thus, there is no motivation to modify Daems since no modification is suggested. There is no reasonable expectation of success when modifying the reference, since no modification is suggested. Thus, there is no *prima facie* case of obvious that has been established.

In support of this obviousness rejection, the Examiner points to five disjointed portions of the reference, including one discussing the prior art. These pieces produce a list of articles to receive the image and lists of chemicals, but there is no teaching or suggestion of Applicants' invention. Applicants respectfully suggest that in the outstanding Action, the rejections evidence "picking and choosing" features of various references and combining them when there is no suggestion in those references to do so. It is impermissible within the framework of a 35 U.S.C. § 103 rejection to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art.

Claims 3-11, 20 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over either Fujimura et al in U.S. Patent No. 5,006,502. The Examiner again argues that the process limitations are not dispositive of the issue of the patentability of the article claims. The Examiner has again failed to establish a *prima facie* case of obviousness. Applicants respectfully traverse these rejections.

The Examiner has not suggested a specific modification to Fujimura that would result in Applicants' claimed product. The outstanding Office Action states a conclusion that Applicants' claims are obvious, but does not state how to modify either reference. Thus, there is no motivation to modify Fujimura since no modification is suggested and no *prima facie* case of obviousness has been established.

Even if there were a *prima facie* case, this reference does not render Applicants' claims obvious. Fujimura describes a heat-transfer sheet that includes a substrate, an image-receiving layer, and a heat migratable dye layer. FIG. 6 schematically illustrates the transfer method using a heat-transfer sheet that transfers an adhesive layer and an image-receiving layer onto an article. After transfer of the image-receiving layer, the dye is transferred onto the image-receiving layer one color at a time as described in column 3, line 64 through column 4, line 6. Each of the colors is successively matched to the layers before it until a full color image is obtained. Applicants respectfully submit that the resulting articles are not the same and that the teachings of Fujimura do not render Applicants' articles obvious.

The product of Applicant's process is less expensive because it is produced by a simpler process, and contains an image that is truer to the original and more consistent in the alignment of the colors. Fujimura requires that a multi-color image be separated into the component primary colors. The image is then rebuilt by aligning the colors, one on top of another. Deconstructing and rebuilding a color image is a complex process, and one that allows much room for error. When the colors are separated, four distinct images are formed, one to be printed in each of magenta, cyan, yellow and black inks. Each of these images is subject to distortion of the image by the decisions made in choosing how to separate the colors. If, for example, the color separation is done by computer. The program looks to each pixel to decide which color, or combinations of colors, should be printed in the area occupied by that pixel. Millions of colors visible to the human eye are converted to combinations of up to four colors, resulting in loss of color information. This requires a number of decisions by the computer as to how to recreate colors of varying hue and tint. Alignment of the colors may not be perfect or may not be consistent from one article to the next. The complexity of this process leads to loss of color information and opportunities to misalign the colors.

Applicants' product is truer to the original image because these opportunities to lose color information and to misalign the colors do not occur. The image is applied to the product in a single step, without color separation. Thus, the process limitation in the product claim does result in a different product. Since the reference does not teach or suggest


transfer of a multi-color image in a single step, Fujimura does not render Applicants' claims obvious.

Reconsideration of the claims and allowance of the rejected claims are respectfully requested. The Examiner should contact the undersigned or Applicants' attorney, John Pilarski, at (847) 657-7698 if a telephonic interview would expedite prosecution, or send correspondence to the address below:

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Respectfully submitted,

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